

### III. REMARKS

#### Status of the Claims

Claims 3, 4, and 6 are amended and claim 8 is cancelled. Claims 1-7, 9-13, 31, and 32 are presented for further consideration.

#### Summary of the Office Action

Claims 1-13, 31-32 stand rejected under 35USC103(a) on the basis of the cited reference Poisenka, U.S. Patent No. 5,926,756 in view of the cited reference Wong et al, U.S. Patent No. 5,881,103. The Examiner is respectfully requested to reconsider her rejection in view of the above amendments and the following remarks.

Applicant submits that the rejections under 35USC112 are fully met by the amendments to claims 3, 4, and 6. These amendments are submitted after final rejection in order to place the claims in condition for allowance or in the alternative to place the claims in better condition for appeal. The Examiner is requested to exercise her discretion and enter these amendments.

In rejecting the claims, the examiner has cited, for the first time, the reference Piosenka as a basis for the obviousness rejections. The citation of this new reference was not necessitated by Applicant's prior amendments and accordingly the issuing of a final rejection is improper under MPEP section 706.07(c) where it is stated:

"While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not

sanction hasty and ill-considered final rejections. The applicant, who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application."

The Examiner is respectfully requested to reconsider the final nature of the pending office action and his rejection in view of the above amendments and the following arguments.

#### Discussion of the Cited References

The newly cited reference Piosenka forms the basis of the rejection based on obviousness. In column 2, lines 52-65, the purpose of Piosenka is described as follows:

"To that end, the present invention allows users of such PEDs to utilize superior human machine interface capabilities provided by personal computers (PC's) to more easily, efficiently and rapidly input the data needed to program PEDs and further provides a simplified means to load the PED programs into the PED. For purposes of this invention, the term "users" includes consumers, sellers, service, support or other individuals who use, sell or support PEDs and might have a need to or benefit from effecting the program of the PED. The term "PC" includes various hardware and operating system software combinations commonly available to users, including those utilizing operating systems such as the Microsoft Windows..."

Accordingly, the system of Poisenka is a PC based system for preprogramming a programmable electronic device, such as a mobile telephone, with the features purchased by the user. This is accomplished as part of the activation of the device. It is designed to set up the device at the time of purchase by connecting to a PC. The Examiner characterizes the disclosure of Piosenka as follows:

"...further the data includes volume controls and ring controls indicates audio parameters (col. 6, lines 43-47), which read connecting to at least one auxiliary device, which as well indicates loading audio parameters into processor of the PC during operation, and providing two communication of the data between the cellular phone (auxiliary device and the PC (mobile communication device) via a serial input/output port associated to the PC and a wire bus associated to the cellular phone."

The teaching of Poisenka fails to describe an auxiliary device of any kind. In the above statement it appears that the Examiner imagines the cellular phone as the auxiliary device and the PC as the mobile communication device. This bears no resemblance to either the system of Poisenka or the system as claimed in this application. In fact the subject invention was devised to avoid the need to return a mobile telephone to the store for updating, whenever the latest accessory is purchased. The system of the subject application allows the optimization of operation between an auxiliary device and a mobile communication device without supplementing the basic programming of the mobile telephone by returning to the store. In the system of Poisenka, a PC is required. There is no teaching that an auxiliary device may be provided with the means to update audio parameters for use with a mobile communication device.

In the system of Piosenka, a personal computer is used to program the cellular telephone before the cellular telephone is put into use, or to update certain features at a later time. After programming the mobile telephone is disconnected from the PC and removed for use at remote locations, as is well known. Whatever is programmed, may be used when needed. The programming may or may not include audio parameters used with a particular auxiliary

device purchased after the programming. The audio parameters of the auxiliary device of this invention are specific to the auxiliary device and are usable upon connection of the auxiliary device to the mobile communication device, while it is connected.

The Examiner indicates that the teaching of Piosenka fails to disclose a digital signal processor and the communication of digital data and then refers to Wong, stating:

"It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Piosenka by incorporating a DSP for the purpose of providing efficient and quality transmission, and adequate processing of data between electronic devices, such as a PC and a cellular phone, via an interface."

As indicated above, the teaching of Poisenka fails to disclose an auxiliary device as described in the claims. The Examiner's description of the deficiencies of Poisenka fails to recognize this gap.

The Examiner is directed to claim 5 of this application which states:

"an auxiliary device connection for connecting an auxiliary device having audio parameters with the mobile communication device;

a microcontroller in said auxiliary device; and

wherein the mobile communication device further comprises communication means for communicating with said microcontroller for loading the audio parameters from the auxiliary device into the means for storing the audio parameters, said communicating being conducted by two way communication of digital data between said

microcontroller of the auxiliary device and said mobile communication device."

Similar features are included in the other independent claims of this application.

During appeal proceedings in this application, the Examiner has admitted that the primary reference Wong, et al does not disclose an auxiliary device for a mobile telephone that has a microcontroller. In addition it is admitted that the auxiliary device of Wong is not capable of two-way communication. Now it appears that the Examiner seeks to remedy the deficiencies of Piosenka by reference to Wong as disclosing what is admittedly absent from the teaching of Wong.

#### **The Issue of Obviousness**

It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application.

Applicant submits that the above described deficiencies of the primary reference Piosenka are not remedied by the proposed combination with the teaching of the reference Wong. The combined references do not therefore support a prima-facie case of obviousness. The modification of the teachings of Piosenka or Wong, in order to obtain the

invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art.

The above arguments apply equally to the rejected dependent claims.

In addition, there is nothing in the cited references that would lead a person skilled in the art to combine the teachings of these references. Piosenka discloses a PC based system for setting up a mobile telephone at the time of activation, while Wong discloses an auxiliary device for a mobile telephone. A person skilled in the art would not be encouraged in anyway to combine the teachings.

The Examiner continues to ignore the claims as a whole, and seeks to dismantle the claims and pursue a search for the individual features. The court admonishes in In re Fritch, 972F.2d1260 as follows:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

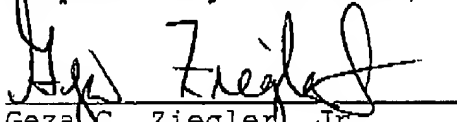
Applicant submits that the only link between the teachings of Piosenka and Wong is the subject invention. The combination of these teachings, therefore, is beyond the scope of 35USC103.

The above arguments apply equally to the rejected dependent claims.

For all of the above reasons, it is respectfully submitted that all of the claims, now present in the application, are novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

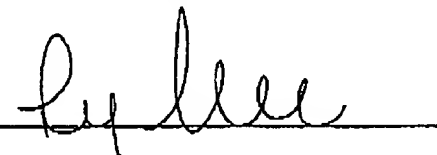
  
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